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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	Q65570	5990

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EXAMINER
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DIVECHA, KAMAL B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/913,885	<b>Applicant(s)</b> TISSERAND ET AL.	
	<b>Examiner</b> KAMAL B. DIVECHA	<b>Art Unit</b> 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Response to Arguments**

Claims 1-7 and 10-16 are pending in this application.

**Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 10-16, drawn to setting up a call channel, classified in class 455, subclass 401.
- II. Claims 8-9, drawn to a transceiver device, classified in class 455, subclass 73 and class 370, subclass 276.

The inventions are distinct, each from other because of the reasons given in the last office action.

Applicant's election with traverse of group I, with claims 1-7 and 10-16 in response filed July 20, 2006 is acknowledged. The traversal is on the ground(s) that: claim 8 recites features which are need for implementing the method according to claim 1. Specifically, applicant notes that claim is directed to transmitting user messages, and therefore the user message must first be stored in a dedicated memory...Thus, applicant submit that there is no material difference between the two groups.

In response to the above argument, the examiner disagrees.

As set forth in MPEP 806.05(d), in order for a restriction to be proper, the examiner must show, by way of example, that one of subcombination has utility other than in the disclosed combination and the examiner has done so in the previous office action.

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In the instant case, it was shown that at least one subcombination is separately usable, i.e. subcombination II has separate utility such as transmitting and receiving signals. See MPEP § 806.05(d).

In response to applicant argument that there is no difference between the two groups, Examiner disagrees. The first group is related to setting up a connection whereas the second group is directed to a network device for interfacing with the network, which sends and receives the signals.

Therefore, the requirement is still deemed proper and is therefore made FINAL.

### **DETAILED ACTION**

#### **Specification**

The disclosure is objected to because the specification does not include one or more sections indicated below.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT

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- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6, 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 11 recites the limitation "the receiver" in the claim. There is insufficient antecedent basis for this limitation in the claim. Furthermore, It is unclear whether sender's receiver or the recipient's receiver is storing message.

Regarding claims 3, 12, the phrase "specific" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 4, 5, 13, 14 recites the limitation “the dedicated memory” in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 6, 15 recites the limitation “the size” in the claim. There is insufficient antecedent basis for this limitation in the claim.

For examining purposes the term “the receiver”, “specific”, “the dedicated memory”, and “the size” would be interpreted as “the recipient’s receiver”, “any command”, “memory” and “size” respectively.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**I.** Claims 1-5, 7, 10-14 and 16 are rejected under 35 U.S.C. 102(e) as anticipated by Crandall et al. (hereinafter Crandall, U. S. Patent No. 6,425,131 B2).

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As per claim 1, Crandall discloses a method of sending a user message through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel (col. 5 L55-67, col. 7 L4-6, col. 4L4-8, L52-60, abstract);
- placing a user message in a spare field of a signaling message for setting up the call channel (Abstract, col. 3 L30-35, col. 5 L1-20, col. 7 L7-12); and then
- performing a signaling stage comprising sending said signaling message (fig. 3 item #311, 312, col. 4 L52-67, col. 7 L12-14); and
- terminating the setting up of the call channel once the user message has been terminated (col. 5 L1-22, fig. 3 item #320).

As per claim 2, Crandall discloses the process wherein the user message is stored in a dedicated memory of the receiver of the user message (col. 4 L29-51, col. 6 L32-48).

As per claim 3, Crandall discloses the process wherein a user is authorized to access the dedicated memory by means of specific commands (col. 6 L32-50).

As per claim 4, Crandall discloses the process wherein the dedicated memory is in a mobile telephone used as a modem and the transmission network is a mobile telephone network (col. 7 L65-67, col. 6 L17-31, col. 5 L30-55 and fig. 1: a mobile telephone and/or PDA does include a modem and memory and obviously a wireless network).

As per claim 5, Crandall discloses the process wherein the dedicated memory is in an ISDN-type modem and an ISDN is used as the transmission network (col. 5 L20-67, col. 3 L5-67, fig. 1).

As per claim 7, Crandall discloses the process wherein the user message is communicated in an enciphered form (i.e. encrypted, col. 3 L5-17).

As per claim 11, Crandall discloses the process wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message (col. 8 L1-57).

As per claims 10, 12-14, 16, they do not teach or further define over the limitations in claims 1-5, 7 and 11. Therefore claims 10, 12-14, 16 are rejected for the same reasons as set forth in claims 1-5, 7 and 11.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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2. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crandall et al. (hereinafter Crandall, U. S. Patent No. 6,425,131 B2) in view of Willhoff (U. S. Patent No. 6,728,548 B1).

As per claim 6, Crandall does not disclose the process wherein the size of the user message is limited to 35 eight-bit bytes at maximum.

Willhoff, from the same field of endeavor, discloses the process wherein the message is limited to 31 bytes at maximum and further teaches that the size of the users message can be any value according to the user's requirements (fig. 6, col. 1 L62-67, col. 2 L16-27, col. 13 L10-15).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Crandall in view of Willhoff in order to limit the size of the user message to 35 bytes.

One of ordinary skilled in the art would have been motivated because the Base Station/Mobile Switching Center/Interworking Function (BMI) limited the mobile station originated data messages to either 31, 63, 127 (Willhoff, col. 2 L16-27).

As per claim 15, it does not teach or further define over the limitations in claim 6. Therefore claim 15 is rejected for the same reasons as set forth in claim 6.

#### **Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Staber, U. S. Patent No. 6,430,410 B1.
- b. Rosenthal et al., U. S. Patent No. 5,737,701: Automatic Authentication System.
- c. Wallenius, U. S. Patent No. 6,466,786 B1: Call setup in Mobile Communications.

Conclusion

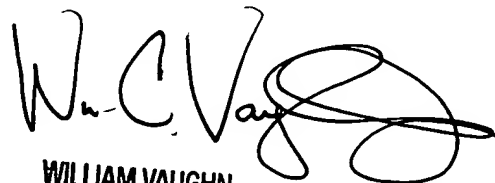
Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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August 5, 2006.



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